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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/441,204	11/16/1999	DAVID VERCHERE	56490.000002	3995

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HUNTON & WILLIAMS  
INTELLECTUAL PROPERTY DEPARTMENT  
1900 K STREET, N.W.  
SUITE 1200  
WASHINGTON, DC 20006-1109

EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/441,204

Applicant(s)

VERCHERE, DAVID

Examiner

Robert M. Pond

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10 and 20-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Declarations filed on 28 April 2003 under 37 CFR 1.131 are sufficient to overcome the 102(a) references.

The Applicant did not amend, add, nor cancel claims. All pending claims, 10 and 20-30, were examined in the non-final office action. New art was cited to overcome the removal of the previously cited 102(a) non-patent literature references.

### ***Response to Arguments***

The Applicant's arguments are founded solely in the removal of 102(a) references overcome by the Applicant's Declaration. Applicant's arguments with respect to claims 10 and 20-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

1. New corrected drawings are required in this application because at least Figures 1 and 3 do not meet margin requirements. Please refer to 37 CFR 1.84 regarding drawing requirements. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are

required in reply to the Office action to avoid abandonment of the application.

The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

2. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Objections***

3. Claims 24 and 39 are objected to because of the following informalities:  
suggest changing "market information" to "the market information." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 10 and 20 are rejected under 35 USC 103(a) as being unpatentable over Imprinted Products (a collection of articles cited in PTO-892, page 1 of 4, Items: U-X and PTO-892, page 2 of 4, Items: U-W hereafter referred to as 2U-2W) and Official Notice regarding databases for catalogs hereafter referred to as "ON1," in view of Archive (a collection of Promomart.com web pages, 16 January 1998, cited in PTO-892, page 2 of 4, Item: X, hereafter referred to as 2X), further in view of Online Auctions (a collection of articles cited in PTO-892, page 3 of 4, Items: U-X, hereafter referred to as 3U-3X).**

Imprinted Products teaches a new comprehensive online promotional products shopping mall, [www.logomall.com](http://www.logomall.com), providing an online catalog of items that can be imprinted with a company's message and/or logo. Imprinted Products teaches Logomall.com providing corporate shoppers finding everything from pens to flashlights to computer accessories in a broad price range, and all of these products being custom imprinted to the client's specifications (please see Item: U, pages 1-2). Imprinted Products teaches a competing online site PromoMart, [www.promomart.com](http://www.promomart.com), providing a catalog of promotional items, organized alphabetically or accessible through a specific product search and a planning calendar that reminds the user of events and holidays (see Item: V, page 1). Imprinted Products teaches Promomart.com becoming the central buying location for promotional products with 10% of the Advertising Specialty Institute (ASI) consultants participating, representing every United States area

code as well as outside the United States. Imprinted Products teaches a) clients of PromoMart consultants using the Internet service to search for unique products that can be imprinted with their company's name and message, b) marketers searching for products according to budget, deadline, or type of product, and c) buyers using a secure shopping cart feature that allows them to order products online. Imprinted Products teaches improving turnaround by giving distributors all the information they need to fulfill the order promptly (see Item: W, pages 1-2). Imprinted Products further teaches PromoMart providing a secure electronic order form and current status and trends in the promotional products industry (see at least Item: X, page 12). Imprinted Products teaches PictureMall, [www.pix.com](http://www.pix.com), an online site containing one of the largest selections of picture gifts on the Internet with over 100 unique items which can be personalized with digital images including photos and graphics. Imprinted Products teaches merchandise ranging from mugs, T-shirts to new and innovative products like cookies and stuffed animals. Imprinted Products teaches consumers uploading their digital image to the website, selecting their gift item, and receiving their delivered customized gift (see Item: 2U, pages 1-2). Imprinted Products teaches customized imprinted products purchased through PictureMall's web site being delivered by express courier (see Item: 2V, page 1). Imprinted Products teaches PictureMall as a one-stop web site for ordering personalized gifts using customer-supplied digital pictures, logos, graphics, and scans (see Item: 2W, page 1). This examiner takes the position that the online

catalog items provided by the promotional products websites are manifestations of information stored in a database managed by a database manager and delivered by the web sever to the user's browser for viewing. Storing and retrieving database means are well-known to one of ordinary skill in the art. This examiner further takes the position that it is well-known to one of ordinary skill in the art to store the uploaded customer information containing imprinted graphics, text, logos, and/or photos into a database.

Imprinted Products and ON1 teach all the above as noted under the 103(a) rejection and teach a) [www.promoart.com](http://www.promoart.com), b) the selection of promotional products from online catalogs, c) the customer supplying company logos and messages online, and d) the uploading of photos and graphics to an imprinted products web site to customized selected products, but do not disclose the actual web pages from the PromoMart promotional products web site to disclose the scope of PromoMart's web-based commerce services. Archive teaches the web pages of Promomart.com (see Item: 2X, pages 1-22) as noted below:

- How to navigate: search for promotional products, add one or more selected products to a shopping cart, check out by selecting a consultant to buy from based on locality or preferred consultant (see at least pages 1-2),
- Search for Products: search by category, price range, and/or production time; or by ASI number or line name; or by product name, or browsing by alphabetical categories (see pages 3-15a),

- Consultant showcase: view by promotional product categories by clicking on an alphabetized category to gain access to web links and descriptions that showcase the consultant (i.e. retailer, distributor) (see page 15b),
- Consultant Search: search by area code, by consultant name, or internationally (see page 16),
- Shopping Cart: review the contents of items in the shopping cart that includes total price for merchandise (see page 17),
- Planning Calendar: reminder of important dates and consultant advertising (Ad Squeeze icon) (see page 18),
- Ad Squeeze: member advertisement featuring ASI number, graphics, text, pricing (see pages 19-21), and
- Idea Store: Online help on ways to run a promotion (see page 22).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to disclose the actual PromoMart web pages as taught by Archive, in order to better understand the scope of web-based commerce services provided by PromoMart, and thereby attract more buyers and promotional products industry companies to the site.

Imprinted Products, ON1, and Archive teach all the above as noted under the 103(a) rejection and teach a) the Internet and World Wide Web gaining in popularity as a viable way to do business in the promotional products industry, b)



more promotional products consultants investing in the Internet as a way to grow their businesses (i.e. one consultant increasing business by 50% through PromoMart's web site), but do not disclose consultants bidding on a customer's order. Online Auctions teaches the current state and well-publicized presence of web-based auction sites being deployed in 1998 to support a variety of industries and consumer interests as noted below:

- FreeMarkets OnLine (buyer-driven): teaches an Internet bidding service that helps buyers of industrial products find the best possible suppliers and then makes those suppliers bid for business, with a guiding principal to drive cost down (see Item: 3U, pages 1-2),
- Ebay (seller-driven): teaches Ebay.com as the category leader of on-line auction houses, and provides a general survey of online auction houses (see Item: 3V, pages 1-3),
- Excite: teaches Excite's Auction Universe and eBay as competitors (see Item: 3W, pages 1-2), and
- Moai, OnSale, FreeMarkets: teaches three companies providing technology and online auctioning services, and further teaches online auction sites springing up like weeds (see Item: 3X, pages 1-2),

Therefore it would have been notoriously obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Imprinted Products, ON1, and Archive to include a bid service as taught by Online

Auctions, in order to allow vendors to compete, and thereby lower the cost of promotional products to buyers.

5. **Claims 21, 23, 25-26, 28, and 30 are rejected under 35 USC 103(a) as being unpatentable over Imprinted Products (a collection of articles cited in PTO-892 Items: U-X and PTO-892 Items: 2U-2W), ON1 regarding databases for catalogs, Archive (a collection of Promomart.com web pages, 16 January 1998, cited in PTO-892 Item: 2X), and Online Auctions (a collection of articles cited in PTO-892 Items: 3U-3X), further in view of Dell Computer (a collection of articles cited in PTO-892, page 4 of 4, Items: U-V, hereafter referred to as 4U-4V; Henson, patent number 6,167,383).**

Imprinted Products, ON1, Archive, and Online Auctions teach all the above as noted under the 103(a) rejection and teach a) customers and suppliers conducting electronic commerce with each other over the Internet through a central product purchasing service, b) and customizing products with company logos, graphics, photos, and messages via electronic commerce systems and methods, and c) online bidding for seller services, but do not disclose products for resale to a group of customers associated with a company wherein the online store is customized for the company. Dell Computer teaches the pertinent problem of providing corporate customers and organizations with their own private online sites for purchasing customizable products. Dell Computer teaches Dell offering its customers an Internet-based, paperless purchase order system

designed to increase order accuracy, aid in receiving product faster, making budget planning easier, reducing duplicate procedures, and providing a single point of reference between the customer and seller. Dell Computer teaches Dell's Premier Pages providing web sites that are customized, password-protected sites created for its corporate and public-sector customers. Premier Pages provide one-stop access to simplified purchasing, purchase history reporting, order status, and help desk support. Dell Computer teaches more than 3,000 customer-specific Premier Page web sites being hosted through Dell's web site at [www.dell.com](http://www.dell.com) (see Item: 4V, page 1). Dell Computer further teaches company-specific web sites as noted below:

- Online specialty stores for customers belonging to a group (e.g. federal government, state & local governments, higher education, healthcare, and businesses) (see at least Item: 4U, pages 6-19; Henson: abstract; col. 3, lines 35-44),
- A database driven shopping cart and configurator that assists the customer in customizing a computer system for purchase, providing automatic price totaling (see at least Henson: Fig. 1 (18, 20, 24); col. 4, line 35 through col. 5, line 65),
- Customized secure websites for individual customer groups managed by Dell Computer's web service that allows large companies and public-sector customers to simplify procurement of Dell products and support

processes (see at least Item: 4U, pages 3-5; Henson: abstract; col. 14, lines 18-61);

- An online mall with links to an institution's special contract pricing based on volume purchase agreements (VPA) (see at least Item: 4U, pages 18-19; Henson: col. 13, lines 29-37),
- Customizing systems using the Dell Online Store shopping cart and check-out process, featuring automatic price update calculations and payment methods (see at least Item: 4U, pages 20-23),
- Option selection impact alert icon that indicates to the buyer that the selected option restricts or limits the selection of other configuration choices for the system and that there is a possible impact to choice of configuration (see at least Item: 4U, page 25),
- Extended Delivery Time Warning icon that indicates to the buyer that the selected option will extend the system's delivery time beyond Dell's standard delivery time frame; clicking the icon provides the earliest delivery date for systems with this component (see at least Item: 4U, page 25),
- Payment options for institutional customers (e.g. purchase order, business lease, line of credit, credit card) (see at least Item: 4U, page 27),
- Shipping options (e.g. next, second, or third business day delivery, lowest cost delivery) (see at least Item: 4U, page 28),

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- Order Watch service that provides e-mail notification when order is shipped (see at least Item: 4U, page 28),
- Delivery Time indication from time order is placed (see at least Item: 4U, pages 28-29),
- Online Store contact page for corporate and institutional customers (see at least Item: 4U, page 30).

Therefore it would have been obvious to one of ordinary skill in the art at time of invention reviewing existing solutions to the pertinent problem of providing customer-specific web sites for purchasing products from a centralized online site to modify the system and method of Imprinted Products, ON1, Archive, and Online Auctions to include customer-specific web sites as taught by Dell Computer, in order to make online shopping for company employees more convenient, efficient, and desirable to use, and thereby attract more corporate clients to the seller's online service.

- 6. Claims 22 and 27 are rejected under 35 USC 103(a) as being unpatentable over Imprinted Products (a collection of articles cited in PTO-892, Items: U-X and PTO-892 Items: 2U-2W), ON1 regarding databases for catalogs, Archive (a collection of Promomart.com web pages, 16 January 1998, cited in PTO-892 Item: 2X), Online Auctions (a collection of articles cited in PTO-892 Items: 3U-3X), and Dell Computer (a collection of articles cited in PTO-892 Items: 4U-4V, and Henson, patent number 6,167,383), as**

**applied to Claims 21 and 26, further in view of Green et al. (PTO-892, pag 4 of 4, Item: W, hereafter referred to as 4W) and Official Notice regarding email reminders hereafter referred to as "ON2."**

*Email reminders*

Imprinted Products, ON1, Archive, Online Auctions, and Dell Computer teach all the above as noted under the 103(a) rejection and teach a) providing an online calendar of events to remind customers to order products, b) providing online alerts and email notifications to customers regarding product status, but do not disclose customers scheduling reminders related to ordering product. Green et al. teach cyberspace winners and features Dell Computer, Amazon, eBay, OnSale, and 1-800-Flowers Inc. Green et al. further teach good merchants to shop, Dell Computer making its site super convenient, and 1-800-Flowers Inc. sending an email to a customer reminding a customer of his wife's birthday. This examiner takes the position that in order for the customer to receive an email reminder to buy his wife a gift and/or flowers for his wife's birthday, the system has to be provided the information so that an email reminder can be scheduled for delivery to the customer in advance of the event. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the viewable only online calendar of Imprinted Products, ON1, Archive, Online Auctions, and Dell Computer to schedule a reminder to order product based on recurring events (e.g. wife's birthday) as taught by Green et al. and ON2, in order to encourage customers to purchase from the online product purchasing site.

7. **Claims 24 and 29 are rejected under 35 USC 103(a) as being unpatentable over Imprinted Products (a collection of articles cited in PTO-892, Items: U-X and PTO-892 Items: 2U-2W), ON1 regarding databases for catalogs, Archive (a collection of Promomart.com web pages, 16 January 1998, cited in PTO-892 Item: 2X), Online Auctions (a collection of articles cited in PTO-892 Items: 3U-3X), and Dell Computer (a collection of articles cited in PTO-892 Items: 4U-4V, and Henson, patent number 6,167,383), as applied to Claims 21 and 26, further in view of Maloney (PTO-892, page 4 of 4, Item: X, hereafter referred to as 4W).**

*Web Hit Habits*

Imprinted Products, ON1, Archive, Online Auctions, and Dell Computer teach all the above as noted under the 103(a) rejection and further teach order status, tracking, purchase history reporting but do not disclose web hit habit reporting. Maloney teaches dozens of companies including Microsoft providing software packages for Web use tracking, and further teaches new software from Accrue Software maintaining logs of activity on the Web servers, recording traffic across the network thus providing a more accurate reading of user behavior (see Item: 4X, pages 1-2). Therefore would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Imprinted Products, ON1, Archive, Online Auctions, and Dell Computer to include a horizontal industry software application to track and report web hit behavior as

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taught by Maloney, in order to better understand user shopping habits, and  
thereby improve the system to create more user buying interest to increase sales  
revenue.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

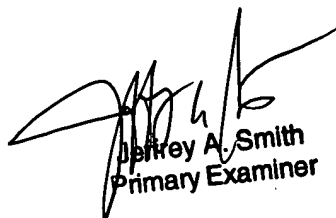
***Washington D.C. 20231***

or faxed to:

**703-305-7687** (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

RMP  
June 23, 2003

  
Jeffrey A. Smith  
Primary Examiner